

THIS DISPOSITION IS
NOT CITABLE AS
PRECEDENT OF THE
TTAB

Mailed: 18 DEC 2002
Paper No. 12
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Hitt Gaines & Boisbrun, P.C.

Serial No. 75/867,933

Glenn W. Boisbrun, Esq. of Hitt Gaines & Boisbrun, P.C.

Ramona F. Ortiga, Trademark Examining Attorney, Law Office
110 (Chris A.F. Pedersen, Managing Attorney).

Before Simms, Holtzman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On December 10, 1999, Hitt Gaines & Boisbrun, P.C.
(applicant) filed a trademark application to register the
mark ABSTRACT on the Principal Register for services
ultimately identified as "Legal services, namely,

intellectual property law and related legal services" in International Class 42.¹

The examining attorney² refused to register the mark on the ground that the mark, when it would be used in connection with applicant's services, is merely descriptive. 15 U.S.C. § 1052(e)(1). After the examining attorney made the refusal to register final, applicant filed this appeal.

We reverse.

The examining attorney submitted a dictionary definition to show that the term "abstract" is defined as "a summary of points (as of a writing) usually presented in skeletal form" and "something that summarizes or concentrates the essentials of a larger thing or several things." Br. at 3. In addition, the examining attorney has submitted printouts that the term "abstract" is a section of a patent application. Therefore, the examining attorney concluded that the word "abstract" is "a descriptive term used in the field of intellectual property to describe the summary of the patent" (Br. at 5), and "consumers would immediately know that the applicant's

¹ Serial No. 75/867,933. The application contains an allegation of a bona fide intention to use the mark in commerce.

'intellectual property and related legal services' feature abstracts" (Br. at 7).

Applicant, on the other hand, maintains that the term "abstract" has multiple meanings and further argues that "intellectual property is an intangible interest; it is not concrete; it is ABSTRACT. When used in connection with legal services in the field of intellectual property, "ABSTRACT" does not only mean a summary of a patent; it also refers to *intangible* interests in ideas and inventions." Br. at 4 (emphasis in original).

A mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or services or if it conveys information regarding a function, purpose, or use of the goods or services. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). See also In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). A term may be descriptive even if it only describes one of the qualities or properties of the goods or services. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods

² The current examining attorney was not the original attorney in this case.

or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 200 USPQ at 218.

We start our analysis by observing that the term "abstract" does refer to a section of a patent.

A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure"... The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure. The abstract will not be used for interpreting the scope of the claims.

37 C.F.R. § 1.72(b). See also Manual of Patent Examining Procedure, § 608.01(b) ("Guidelines for the preparation of patent abstracts").

However, in order for a term to be merely descriptive, it must describe, at least, "a single, significant quality, feature, function, etc." of the services. In re Venture Lending Associates, 226 USPQ 285, 286 (TTAB 1985) (emphasis added). There is no evidence in this case to indicate that "abstracts" are a significant feature of applicant's legal services. The mere fact that it is a part of a patent application does not make it significant. There is no indication that customers are interested in abstracts when they are purchasing patent application drafting services. For example, the Board has held that the term "Pencils" was

merely descriptive when used in association with retail stationery and office supply stores even though it was not the central characteristic of the applicant's services. In re Pencils Inc., 9 USPQ2d 1410, 1412 (TTAB 1988). As in Pencils, "abstracts" are not a central characteristic of applicant's services. However, unlike Pencils, there is no evidence that "abstracts" are a separate, identifiable service offered as intellectual property legal services such as patent or trademark application drafting. While intellectual property legal services may involve patent application drafting, that does not mean that every term that may be associated with patent applications is merely descriptive of the services. Similarly, while a stationery store may sell goods made of "wood," "metal," or "plastic," that does not make these terms merely descriptive for stationery store services. The examining attorney has not shown that prospective customers of intellectual property law services are in the market for abstract services or that they consider this term to refer to a significant feature of the services.

In a similar case, an applicant touted its laser technology as the reason its high fidelity loudspeakers were superior to its competitors. The Board did not find that this established that the term "laser" was merely

descriptive of the goods. "We conclude that the term 'LASER' requires mature thought and imagination in order to determine what features or characteristics applicant's goods possess." In re The Rank Organization Limited, 222 USPQ 324, 326 (TTAB 1984) (The "fact that the term "LASER" is capable of being analyzed does not render the term merely descriptive"). Similarly, applicant's mark ABSTRACT requires mature thought and imagination to conclude that it might refer to a part of an application for a patent that an inventor might be seeking.

Another reason why we do not find the mark merely descriptive is because it is subject to several meanings and these meanings do not necessarily immediately describe a feature or characteristic of applicant's services. The examining attorney has included a definition of abstract as "a summary of points (as of a writing) usually presented in skeletal form." Office Action dated January 22, 2001, attachment 1. The term could be applied to a wide variety of documents prepared by a law firm. In addition, applicant points out that the examining attorney's definitions include "considered apart from concrete existence." Office Action dated October 17, 2001, attachment 1. Applicant argues that "intellectual property is an intangible interest; it is not concrete; it is

ABSTRACT. When used in connection with legal services in the field of intellectual property; 'ABSTRACT' does not only mean a *summary* of a patent; it also refers to *intangible* interests in ideas and inventions." Br. at 4. Thus, prospective purchasers may view the term "abstract" as suggestive of the field of intellectual property law, which involves abstract or intangible property.

In short, we have serious doubts that the term "abstract" when applied to intellectual property law and related legal services immediately informs prospective purchasers of a significant feature of the services. It is a well-established principle of trademark law, that if we have any doubts about the descriptiveness of a mark, we are to resolve them in the applicant's favor. In re Morton-Norwich Products, Inc., 209 USPQ 791, 791 (TTAB 1981) (The Board's practice is "to resolve doubts in applicant's favor and publish the mark for opposition"). Therefore, we do so in this case.

Decision: The refusal to register applicant's mark ABSTRACT for the identified services on the ground that the mark is merely descriptive is reversed.